

## REMARKS

### Claim Rejections

In section 4 of the Office Action, the Examiner rejected claims 1-12 and 14 under 35 U.S.C. § 103 in view of U.S. Patent No. 5,783,293 to Lammi (“Lammi”) modified by U.S. Patent No. 5,823,890 to Maruko *et al.* (“Maruko”).

The Applicants respectfully traverse the Examiner’s rejections. Maruko appears to disclose a golf ball having a multi-layer cover, the cover layers preferably being the same color but allowing for a minor variation in color. *See* col. 2, line 66 to col. 3, line 3. In fact, the very language of Maruko makes clear that any difference in color between the cover layers should be only so great so that the color of the inner layer does not show through the outer layer after heat compression molding the golf ball layers:

According to the invention, the color difference  $\Delta E$  between the inner and outer layers of the cover should be up to 3, preferably in the range of 0 to 1.5. With a color difference  $\Delta E$  within the range of 0.1 to 1.5, the two layers cannot be discriminated by visual observation. A color difference  $\Delta E$  of more than 3 means that the inner and outer layers of the cover are so different in color that tracks of seams and streaks on the inner layer appear prominent at the parting line of a completed product. That is, the product has outer appearance defects.

col. 2, line 66 to col. 3, line 8. Thus, it is clear from the express language of Maruko that any color difference between the separate cover layers should be minimized, and more preferably avoided altogether.

However, there is *no* teaching nor suggestion for what is actually recited in the instant claims - “forming a multi-color layer.” That is, a single layer having multiple colors. The entire thrust of Maruko is to avoid visible color differentiation. *See, for example*, Maruko at col. 1, lines 43-48. Thus, the Examiner has failed to identify each and every recitation of the claims, a requirement for a proper rejection. *See, for example*, MPEP § 2143.03.

The Applicants further traverse the Examiner's rejections of the dependent claims. In general, the Examiner improperly relies upon hindsight reasoning, merely restates the Applicants' disclosure, and otherwise fails to suggest proper motivation for the proffered modification of Lammi. The Applicants make no specific statement here, however, as the allowability of each dependent claim is established above via the allowance of independent claim 1.

In view of the foregoing, the Examiner's rejections of the claims are believed to be overcome.

#### Assertions of "Well Known"

Regarding the Examiner's three separate assertions of claim elements being "well-known in the golf ball art," including that having outer and inner cover layers being the same thickness and that forming a substantially translucent cover over a multicolor golf ball layer, the Applicants request the Examiner, in accordance with 37 C.F.R. § 1.104(d)(2), provide support for such assertion. *See, also, In re Lee*, 277 F.3d 1338, 1344-45, (Fed. Cir. 2002) (finding that reliance on "common knowledge and common sense" did not fulfill the Patent Office's obligation to cite references in support of its conclusions).

#### Added Claims

The Applicants have added new claims 15-18 to further define the instant invention. No new matter is added.

### Additional Fees

The Commissioner is hereby authorized to charge any insufficiency or credit any overpayment associated with this application to Bingham McCutchen LLP Deposit Account No. 19-5127 (order no. 4020002.4200020383).

It should be noted that this Response is timely filed without an extension of time, as October 7, 2006 was a Saturday and Monday, October 9, 2006 was a federal holiday within the District of Columbia.

### Conclusion

Claims 15-18 have been added. Claims 1-18 are pending in the application, and are believed to be in condition for allowance. In view of the foregoing, all of the Examiner's rejections of the claims are believed to be overcome. The Applicants respectfully request reconsideration and issuance of a Notice of Allowance for all claims. Should the Examiner feel further communication would help prosecution, the Examiner is urged to call the undersigned at the telephone number provided below.

Respectfully Submitted,



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